UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/724,799	12/01/2003	Thomas Hanna	2002P16048US	5524

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SIEMENS CORPORATION
INTELLECTUAL PROPERTY DEPT.
170 WOOD AVENUE SOUTH
ISELIN, NJ 08830

EXAMINER
WHIPPLE, BRIAN P

ART UNIT	PAPER NUMBER
2452	

MAIL DATE	DELIVERY MODE
10/24/2008	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

	Application No.	Applicant(s)
Office Action Summary	10/724,799	HANNA ET AL.
	Examiner	Art Unit	
	BRIAN P. WHIPPLE	2452	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>28 August 2008</u>.

2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) <u>1-7, 21-24 and 32-35</u> is/are pending in the application.

   4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) <u>1-7, 21-24 and 32-35</u> is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

   Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

   Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

   a)☒ All   b)☐ Some * c)☐ None of:

   1.☒ Certified copies of the priority documents have been received.

   2.☐ Certified copies of the priority documents have been received in Application No. _____.

   3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

   * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☒ Notice of References Cited (PTO-892)
2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3)☐ Information Disclosure Statement(s) (PTO/SB/08)
   Paper No(s)/Mail Date _____.

4)☐ Interview Summary (PTO-413)
   Paper No(s)/Mail Date. _____ .
5)☐ Notice of Informal Patent Application
6)☐ Other: _____.

DETAILED ACTION

1.   Claims 1-7, 21-24, and 32-35 are pending in this application and presented for

examination.

Continued Examination Under 37 CFR 1.114

2.   A request for continued examination under 37 CFR 1.114, including the fee set forth

in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is

eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR

1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn

pursuant to 37 CFR 1.114. Applicant's submission filed on 8/28/08 has been entered.

Response to Arguments

3.   A response to arguments was given in the advisory action mailed on 8/15/08 (along

with an indication that the amended subject matter required further consideration and/or

search). No new arguments are given by Applicant following the entering of the RCE.

Therefore, the Examiner is responding to the claim amendments only.

Claim Objections

4.   As to claim 3, "a instant messaging system" is grammatically incorrect. The phrase

should read "an instant messaging system".

Claim Rejections - 35 USC § 112

5.   The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming
> the subject matter which the applicant regards as his invention.

6.   Claims 1-7, 21-24, and 32-35 are rejected under 35 U.S.C. 112, second paragraph, as

being indefinite for failing to particularly point out and distinctly claim the subject matter

which applicant regards as the invention.

7.   As to claim 1, line 9, the phrase "the presence application" lacks antecedent basis.

8.   As to claims 2-7, 21-24, and 32-35, the claims are rejected due their dependency on,

and inclusion of the indefinite language of, independent claim 1.

Claim Rejections - 35 USC § 103

9.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in
section 102 of this title, if the differences between the subject matter sought to be patented and the prior art
are such that the subject matter as a whole would have been obvious at the time the invention was made to a
person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be
negatived by the manner in which the invention was made.

10.   Claims 1-4, 6-7, and 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over

McDowell et al. (McDowell), U.S. Publication No. 2002/0035605 A1, in view of Tzann-en

Szeto (Szeto), U.S. Publication No. 2004/0215731 A1.

11.   As to claim 1, McDowell discloses a method for remotely monitoring a software

application in a packet-switching network (Abstract, ln. 1-4; [0050], ln. 5-8), comprising:

        registering the software application by a monitoring application as a first

communication partner in a list of communication partners accessible in the network, the

software application residing on a first computing machine ([0096] – [0097]; in order to

communicate with IM users, an IM user must install the IM program and register an account

and buddy list with the IM server; therefore the IM user's IM program is a software

application and the monitoring application is the IM server);

        registering the presence application in the list as a second communication partner

which monitors the first communication partner, the presence application residing on a

second computing machine ([0049], ln. 6 – [0050], ln. 5; [0051]; [0052], ln. 1-2 and 7-16;

especially [0052], ln. 1-2, "The Presence Server… power[s] the buddy list.");

remotely monitoring the software application by the registered presence application ([0049] – [0050]; [0052], ln. 7-16); and

transmitting the state of the software application to the presence application as a message transmitted from the first communication partner, wherein the monitoring is carried out on the basis of the message ([0052, ln. 7-16; Page 5, TABLE 1, § ON - <user defined>…).

McDowell is silent on transmitting information identifying the software application to be monitored to the first computing machine, the information including the name of the software application.

However, Szeto discloses transmitting information identifying a software application to be monitored to a first computing machine, the information including the name of the software application ([0082] – [0084]).

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the teachings of McDowell by transmitting information identifying a software application to be monitored to a first computing machine, the information including the name of the software application as taught by Szeto in order to enable activities such as co-searching, co-browsing, co-drawing, games, etc. (Szeto: [0094]).

12.   As to claim 2, McDowell and Szeto disclose the invention substantially as in parent

claim 1, wherein a control instruction for controlling the software application is transmitted

from the presence application to the monitoring application (McDowell: [0056], ln. 4-7 and

13-15; instructions regarding other users presence are transmitted to the client in order to

control how the status of the other users on the client's buddy list presented to the client).

13.   As to claim 21, McDowell and Szeto disclose the invention substantially as in parent

claim 2, wherein the control instruction is transmitted to the monitoring application as an

instant message (Szeto: [0094]).

14.   As to claim 22, the claim is rejected for reasons similar to claim 21 above.

15.   As to claim 3, McDowell and Szeto disclose the invention substantially as in parent

claim 1, wherein a instant messaging system is used for registration (McDowell: [0056], ln. 1-

7).

16.   As to claim 4, McDowell and Szeto disclose the invention substantially as in parent

claim 1, wherein the transmission of the state is secured by a handshake process (McDowell:

[0081], ln. 5-7; [0139]; TCP/IP is known in the art to include a handshake process).

17.   As to claim 6, McDowell and Szeto disclose the invention substantially as in parent

claim 1, wherein the software application is monitorable by a plurality of presence

applications (McDowell: Fig. 7; [0048]; [0049], ln. 6-8), and a plurality of software

applications are monitorable by the presence application (McDowell: [0051]; [0056], ln. 4-7).

18.   As to claim 7, McDowell and Szeto disclose the invention substantially as in parent

claim 1, wherein the monitoring application which is associated with a software application

to be monitored is automatically registered in the list (McDowell: [0096] – [0097]; [0150]).

19.   As to claim 23, McDowell and Szeto disclose the invention substantially as in parent

claim 1, wherein the monitoring the software application comprises:

        entering, by a user of the second communication partner, the information identifying

the software application prior to the transmitting (Szeto: [0084]).

20.   As to claim 24, the claim is rejected for reasons similar to claim 23 above.

21.   As to claim 32, McDowell and Szeto disclose the invention substantially as in parent

claim 1, wherein the second computing machine receives the software application

identifying information (Szeto: [0084]), and

        wherein the software application is located in response to receiving the information

(Szeto: [0084]).

22.   As to claim 33, the claim is rejected for reasons similar to claim 7 above.

23.   Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over McDowell and

Szeto as applied to claim 1 above, further in view of IETF; 2.1.12 SIP for Instant Messaging

and Presence Leveraging (simple); 7/31/01.

24.   As to claim 5, McDowell and Szeto disclose the invention substantially as in parent

claim 1, wherein the registration of the software application and the transmission of the state

are carried out using an SIP infrastructure (McDowell: [0141], ln. 7-12), but are silent on the

SIMPLE extension to the SIP protocol.

        However, IETF discloses the SIMPLE extension to the SIP protocol (Pg. 1, heading).

        It would have been obvious to one of ordinary skill in the art at the time of the

invention to modify the teachings of McDowell and Szeto by expanding on the use of SIP to

include the SIMPLE extension as the motivations for using both are to make use of an

interoperable standard.

SIMPLE extends SIP to instant messaging and presence leveraging. As McDowell is

directed to presence detection and instant messaging and discloses the use of SIP, the

incorporation of SIMPLE is an obvious one in order to make use of a suite of services for

instant messaging and presence through an interoperable standard (**Description of Working**

Group, ¶ 1).

25.   Claims 34-35 are rejected under 35 U.S.C. 103(a) as being unpatentable over

McDowell and Szeto as applied to claim 1 above, and further in view of Enete et al. (Enete),

U.S. Publication No. 2003/0208543 A1.

26.   As to claims 34-35, McDowell and Szeto disclose the invention substantially as in

parent claim 1.

The use of both IP addresses and host names may be interpreted as being a part of

McDowell and Szeto combination as McDowell discloses an instant messaging system in a

TCP/IP environment (McDowell: [0081]; [0139]). A message sent to a screen name in

McDowell must translate that information into a corresponding, receiving IP address in

order to communicate messages in a TCP/IP instant messaging environment.

Failing this, Enete discloses an instant messaging system in which IP addresses and/or

host screen names are sent in messages to identify communication partners ([0067]).

It would have been obvious to one of ordinary skill in the art at the time of the

invention to modify the teachings of McDowell and Szeto by explicitly using IP addresses

and/or host screen names to contact communication applications in an instant messaging

environment as taught by Enete in order to enable communications using standardized

means of network communication, thereby preventing the need for a system to develop its

own communications standard and encourage interoperability with other systems/networks.

Conclusion

27.   Any inquiry concerning this communication or earlier communications from the

examiner should be directed to BRIAN P. WHIPPLE whose telephone number is (571)270-

1244. The examiner can normally be reached on Mon-Fri (10:30 AM to 7:00 PM EST).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, John Follansbee can be reached on (571) 272-3964. The fax phone number for

the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent

Application Information Retrieval (PAIR) system. Status information for published

applications may be obtained from either Private PAIR or Public PAIR. Status information

for unpublished applications is available through Private PAIR only. For more information

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(toll-free). If you would like assistance from a USPTO Customer Service Representative or

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571-272-1000.

Brian P. Whipple
/B. P. W./
Examiner, Art Unit 2452
10/19/08

/Kenny S Lin/
Primary Examiner, Art Unit 2452